

REMARKS/ARGUMENTS

Applicant appreciates the Examiner's continued thorough search and examination of the present patent application.

Claims 1 and 14 have been amended, and claim 13 has been canceled. No new matter has been added.

Claims 1, 3-4, 6, 10 and 12-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Oscar et al. ("Oscar," U.S. Patent Application Publication No. 2001/0037216) in view of Ullman ("Ullman," U.S. Patent Application Publication No. 2002/0002495) and further in view of Freeman, Jr., et al. ("Freeman," U.S. Patent Application No. 6,012,035). Applicant respectfully traverses this rejection.

Applicant respectfully submits that elements defined in claim 1, as amended, are not taught, suggested or disclosed by either Oscar, Ullman and Freeman, nor does the combination of those references teach, suggest or disclose the missing elements of applicant's claim 1. Since elements of applicant's claim 1 are missing from each of Oscar, Ullman and Freeman, the combination of those references cannot render the claims obvious under 35 U.S.C. §103(a).

Applicant submits that each of Oscar, Ullman and Freeman concerns a similar, prior art pharmacy benefits structure, and that applicant's claim 1 is patentably distinct therefrom. Each of Oscar, Ullman and Freeman requires a sponsor to pay at least a portion of every prescription that is filled by a pharmacy. See, for example, Fig. 7 of Oscar wherein "Sample Employer 1" has paid \$198.85 for prescription drugs and the subscriber, and "John Customer 21" has paid only \$40. See also, for example, Fig. 2 and paragraph 33 of Ullman, wherein a determination is made in step S49 for a coordination of benefits between "primary insurance carriers and secondary insurance carriers," for example "in situations where the primary insurance plan requires significant deductible contributions from the consumer, maximum benefit allowances or excludes certain necessary items (e.g., "lifestyle" medications such as obesity or hair loss treatments)." See also Fig 3., step 108 and column 8, lines 21-26 of Freeman, wherein "the insurance company adjudicates the claim and directs the bank to pay[.]" In each of the references, a plan sponsor, often an insurance company, ultimately is involved in adjudicating claims.

Applicant's amended claim 1, in contrast, recites "providing prescription benefits to

subscribers” that is “100% subscriber co-pay less [a] portion of the cost of a prescription for which a participating pharmacy is responsible” Claim 1 further recites “designing” a prescription benefits plan that includes “a portion of a cost of a prescription that a subscriber is responsible for, an amount of co-payment to be tendered by the subscriber at time of dispensing, and a portion of the cost of the prescription for which a participating pharmacy is responsible.” Unlike Oscar, Ullman and Freeman, no insurer or sponsor is held responsible for costs associated with a prescription. Further, applicant’s claim 1 recites “[charging a] subscriber’s credit account for accepted claims, the amount of the charge being equal to the price of the prescription minus a predetermined co-payment which is tendered by the subscriber to the pharmacy at the time of fulfilling the prescription.” Applicant’s claim 1 further requires “making a first payment by the creditor to the prescription benefits manager, the first payment being equal to the amount charged to the subscriber’s account minus a first predetermined service fee to be retained by the creditor,” “making a second payment by the prescription benefits manager to the pharmacy, the second payment being equal to a predetermined portion of the prescription price,” and “making a third payment by the prescription benefits manager to the claims processor, the third payment being equal to a predetermined service fee, wherein the second payment and the third payment are funded by the first payment.”

Accordingly and unlike Oscar, Ullman or Freeman, the subscriber’s credit account is charged the “price of the prescription minus a predetermined co-payment,” and that amount is used to fund “the second payment and the third payment.” Unlike Ullman, Oscar and Freeman, applicant’s claimed prescription benefits plan requires a 100% co-pay by the uninsured subscriber less a portion of the cost of a prescription for which a participating pharmacy is responsible. Therefore, at least a portion of the pharmacy’s compensation is provided through the prescription benefits manager, thereby providing an incentive for the pharmacy to adjudicate the subscriber’s prescription claims with the prescription benefits manager and, notwithstanding the co-pay nature of applicant’s claim 1, assuring the subscriber of patient advocacy. Oscar, Ullman and Freeman provide no such incentive under such a co-pay plan.

Claims 3-4, 6, 10, 12 and 14 depend directly or indirectly from claim 1 and are, therefore, patentable for the same reasons as well as because of the combination of elements in those claims with the features set forth in the claim(s) from which they depend.

Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Oscar in view of Ullman and further in view of Freeman and Judge (“Judge,” U.S. Patent Application Publication No. 2002/0111832). Applicant respectfully traverses this rejection.

Judge is cited for teaching performing a drug regimen review prior to approving a claim, and advising a pharmacy of the review results. Applicant respectfully submits, however, that Judge does not teach or suggest the missing elements. Judge, instead, is directed to delivering a pharmaceutical prescription copay counselor over an internet protocol network. As described above with reference to Oscar, Ullman and Freeman, Judge does not teach or suggest applicant’s missing elements, including designing a prescription benefits plan as recited in amended claim 1. See, for example, Fig. 1 and paragraph [0028] of Judge, wherein “insurance companies and pharmacy benefit providers” 140 contribute to costs associated with prescriptions. Judge does not teach or suggest “making a first payment by the creditor to the prescription benefits manager” that is “equal to the amount charged to the subscriber’s account minus a first predetermined service fee to be retained by the creditor.” Further, Judge does not teach or suggest “making a second payment by the prescription benefits manager to the pharmacy” that is “equal to a predetermined portion of the prescription price,” and “making a third payment by the prescription benefits manager to the claims processor” that is “equal to a predetermined service fee.” Accordingly, applicant respectfully submits that the addition of Judge with Oscar, Ullman and Freeman does render applicant’s claim 2, which depends directly from claim 1, obvious under 35 U.S.C. §103(a). Reconsideration is respectfully requested.

Claims 5, 7-9 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Oscar in view of Ullman and further in view of Freeman and Mayaud (“Mayaud,” U.S. Patent No. 5,845,255). Applicant traverses this rejection.

Mayaud is cited for teaching adjudicating a claim by checking a prescription against a formulary and recommending medications to the pharmacy for fulfilling the prescription. Applicant respectfully submits that, for the reasons cited above with regard to Judge, Mayaud does not teach or suggest the missing elements that are missing from the combined teachings of Oscar, Ullman and Freeman. Mayaud is directed to a clinical prescription management system for improving the quality of prescriptions that are written by physicians (see column 4, lines 21-26), and is replete with references to insurers and insurance companies providing benefits.

Therefore, claims 5, 7-9 and 11, which depend directly or indirectly from claim 1, are patentable as well as because of the combination of features in those claims with the features set forth in the claim(s) from which they depend.

Accordingly, and for the reasons set forth above, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this application to issue.

THIS CORRESPONDENCE IS BEING
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Respectfully submitted,



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